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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,129	09/16/2003	Allen Fox	08226/1203097-US1	7169

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EXAMINER	
ELISCA, PIERRE E	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/667,129	FOX ET AL.	
	Examiner	Art Unit	
	Pierre E. Elisca	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 August 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-84* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 08/28/2006.

2. Claims 1-84 are pending.

3. The rejection to claims 1-84 under 35 U.S.C. 103 (a) as being unpatentable over Allan et al (U.S. Pat. No. 6,526,456) and Bass et al (U.S Pat. No. 6,744,446) in view of Hornbuckle (U.S. Pat. No. 5,613,089) as set forth in the office action mailed on 04/25/2006 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-82 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Allan et al (U.S. Pat. No. 6,526,456) and Bass et al (U.S Pat. No. 6,744,446) in view of **Hornbuckle (U.S. Pat. No. 5,613,089).**

As per Claims 1, 4-84 Allan substantially discloses a software product that can be freely distributed while limiting its use to authorized subscribers, the method comprising:

a set of users including identify one or more software products that are rented by users in the set (see., abstract, col 1, lines 4-8, col 4, lines 63-67, col 5, lines 1-15); Authorizing a user in the set to access a software product through the computer network based on whether the software product is identified as a rented software product (see., abstract, col 1, lines 4-8, col 4, lines 63-67, col 5, lines 1-15).

Allan fails to explicitly disclose the step of assigning a virtual container (s) to users. However, Bass discloses a method/apparatus for displaying network (network or online) information to a user connected to a network, and enable a user to configure the network by assigning virtual containers (see., abstract, col 2, lines and 67 and 68, col 3, lines 1-8). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the software rental service of Allan by including the limitation detailed above as taught by Bass because this would improve software rental product.

Allan and Bass fail explicitly to disclose the claimed limitation wherein said the collection identifying a rental package of a predefined number of the one or more software products. Hornbuckle discloses a system/method for renting computer game software. Each game software package for each different game available for rental is assigned an 8-character package identifier code which is unique to the particular game. Each software package is encrypted with a package key, the package key being the unique package identifier associated with each different game available (see., abstract, col 16, lines 24-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Allan and Bass by

including the limitation detailed above as taught by Hornbuckle because this would prevent unauthorized use, copying, vandalism and modification of downloadable data and programs during or after transmission to the target computer.

As per claims 2 and 3, Allan discloses the claimed method of identifying the rented software product in the virtual container for a rental period (see., col 9, lines 24-37).

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 08/28/2006 have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant respectfully submits that the newly cited Hornbuckle reference does not disclose or suggest:

a. The limitation identified in the OA. As indicated above, and also in the previous OA, Allan and Bass fail to explicitly disclose the claimed limitation wherein said the collection identifying a rental package of a predefined number of the one or more software products. Hornbuckle discloses a system/method for renting computer game software. Each game software package for each different game available for rental is assigned an 8-character package identifier code which is unique to the particular game. Each software package is encrypted with a package key, the package key being the unique package identifier associated with each different game available (see., abstract, col 16,

lines 24-62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Allan and Bass by including the limitation detailed above as taught by Hornbuckle because this would prevent unauthorized use, copying, vandalism and modification of downloadable data and programs during or after transmission to the target computer.

Please note that the package key which being the unique package identifier associated with each different game is readable as a rental package identifier, and the 8-character package identifier code is interpreted as a predefined number.

b. One of ordinary skill in the art would NOT be motivated to combine Hornbuckle with Allan and Bass. However, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter);

and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981): Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on571 272 6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pierre Eddy Elisca

Primary Examiner

October 19, 2006